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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,951	04/11/2001	John Chad Parry	262/117	7691

22249 7590 01/31/2005

LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES, CA 90071

EXAMINER	
BASEHOAR, ADAM L	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Offic Action Summary	Application No.	Applicant(s)	
	09/829,951	PARRY, JOHN CHAD	
	Examiner	Art Unit	
	Adam L Basehoar	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2001*.

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/26/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: The Application filed on 04/1/01 and the IDS filed on 06/26/01.

2. Claims 1-29 are pending in the case. Claims 1, 18, 23, and 29 are independent claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No.09/829952. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while the instant application does not teach a business method, it would have been obvious to one or ordinary skill in the art at

the time of the invention to have used said method as a business method to generate a tangible profit.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11, 17-20, and 23-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US: 6,336,116 01/01/02).

-In regard to independent claims 1 and 18, Brown teaches a hosted application service comprising:

providing an instruction (code)(columns 2 & 10, lines 25-28 & 10-32) to be embedded in a customer document (Fig. 8: 61) wherein said instruction retrieves hosted service information from an application service provider system (column 2, lines 29-42) (Fig. 9)

and seamlessly integrates said information into said customer document at a user location (Fig.8: 61 & 12A-C).

-In regard to dependent claim 2, Brown teaches wherein said document does not reside on said application server (column 2, lines 9-15).

-In regard to dependent claim 3, Brown teaches wherein said application service provider includes a server (column 14-18)(Fig. 9: 66 & 4), HTML web page document (columns 8 & 10, lines 3-5 & 10-32), and a user web browser (column 8, lines 3-8).

-In regard to dependent claim 4, Brown teaches wherein said instruction retrieves hosted application service information by initiating a service resource request (search query) from said provider server (column 2, lines 29-42).

-In regard to dependent claim 5, Brown teaches wherein said instruction further directs dynamic information (search query & provider identifier information)(column 2, lines 30-36) to be passed to said application service provider server during said resource request (column 2, lines 30-36).

-In regard to dependent claim 6, Brown teaches wherein said dynamic information was passed to said application service provider using a query string (column 2, lines 32-36).

-In regard to dependent claim 7, Brown teaches wherein said dynamic information was passed to said application service provider using a cookie (equivalent to passing the provider identifier and user query to the application service provider)(column 2, lines 33-36).

-In regard to dependent claim 8, Brown teaches wherein said hosted application service information (documents and URL's) was determined in response to said dynamic information (column 2, lines 36-42).

-In regard to dependent claim 9, Brown teaches wherein said application service information comprises a link (documents or URL's to documents)(column 2, lines 36-42) to a document residing on said customer server.

-In regard to dependent claim 10, Brown teaches wherein said link was coded so as to preserve dynamic information by including the provider identifier (column 2, lines 34-40).

-In regard to dependent claim 11, Brown teaches wherein said link was coded so as to preserve information using session variables by including the session variable provider identifier (column 2, lines 34-40).

-In regard to dependent claim 17, Brown teaches wherein said hosted application service information comprises a second instruction that retrieves new hosted service

information (a second hosted search) from an application service providers server and integrates said new information into said customer document (Fig. 12A: 89) at said user location (columns 9 & 10, lines 67 & 1-2).

In regard to dependent claim 19, Brown teaches wherein said document is an HTML web page (columns 8 & 10, lines 3-5 & 10-32) that does not reside on the application service provider server (column 2, lines 10-12) and said user location comprises a browser (column 8, lines 3-8).

In regard to dependent claim 20, Brown teaches wherein said instruction directs dynamic information (user query and provider identifier) to be passed to said application service provider during said resource request (column 2, lines 32-39) and said hosted application service information was determined in response to said dynamic information (column 2, lines 39-43).

-In regard to independent claim 23, Brown teaches a business method providing:
providing an administrative interface via a computer network (Fig. 6A-1-2 & Fig. 6B-1-2);
providing, via said administrative interface, an instruction (code) to be embedded in a customer document (column 2, lines 25-28), and
providing a hosted service (site-specific searching) in response to said instruction (column 2, lines 10-15).

-In regard to dependent claim 24, Brown teaches wherein said instruction (code)(column 2, lines 25-28) retrieves hosted service information (search capabilities) from an application service provider server (host computer system)(Fig. 9: 66) and integrates said information into said customer document at the user location (Fig. 8: 61).

-In regard to dependent claim 25, Brown teaches the interface (Fig. 6A-1 & 6A-2) comprises tools adapted to customize the appearance of said information within said customer document by limiting the scope of the search and indexing of the registered documents (Fig. 6B-1 & 6B-2) as well as providing the instruction to be embedded at any user location in the customer document (columns 2 & 10, lines 25-28 & 132)(Fig. 7 & 8: 61).

-In regard to dependent claim 26, Brown teaches wherein said interface comprises a customer account enrollment form (column 6, lines 14-21)(Fig. 6A-1 & 6A-2).

-In regard to dependent claim 27, Brown teaches wherein said hosted application service comprises a hosted site search engine (column 2, lines 10-15)(Fig. 8: 61).

-In regard to dependent claim 28, Brown teaches wherein said business method further comprises the step of providing a robot to index a customer web site (columns 2 and 6, lines 21-24 & 55-58)(Fig. 3: 35).

-In regard to independent claim 29, Brown teaches a business method comprising:

providing, upon request of a user for a web page (column 8, lines 3-8), hosted application service information from a remote location (column 2, lines 10-15), said information being integrated into a customer document at a user location (column 2, lines 25-28) such that it appears to the user that the information came from a network document of said customer (column 2, 29-42)(Fig. 8: 61 & 12A-C).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 12-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US: 6,336,116 01/01/02).

-In regard to dependent claims 12 and 21, Brown teaches wherein the provider identifier preserved the session information in the form of a web cookie (column 2, lines 33-36) as taught above in claims 7 and 11. Web cookies are well known in the art to provide data persistent session variables such as a user profile or preferences between a user's browser and a web server. Brown does not teach wherein said link was coded to preserve information using the data persistence technique of URL munging. It would have been obvious to one of ordinary skill in the art at the time of the invention for Brown to have used URL munging to preserve session information, because URL/URI munging, the well known process of storing session identifiers and user variables as part

of a web site's URL, would have reduced the notoriously well known privacy and security concerns regarding the cookie data in Brown. Said concerns, which could result in some web site users disabling cookies on their browsers and disabling the search capabilities in the process, would thus be averted.

-In regard to dependent claim 13, Brown teaches where said instruction was an HTML tag (column 10, lines 10-32).

-In regard to dependent claim 14, Brown teaches wherein the service resource was code (column 10, lines 10-32). Brown does not teach wherein said service resource was a JavaScript file. It would have been obvious to one of ordinary skill in the art at the time of the invention for the service resource of Brown to have been a JavaScript file, because it was notoriously well known in the art that JavaScript was a quicker and simpler language for enhancing Web pages and servers, wherein JavaScript is embedded as a small program (code) in a web page that was interpreted and executed by the Web client to provide increased functionality, which in the case of Brown was the hosted site search engine.

-In regard to dependent claims 15 and 16, Brown teaches wherein said link was a text input (Fig. 8: 61) HTML form (column 10, lines 10-32) for a search engine (column 8, lines 9-11)(Fig. 8: 61).

-In regard to dependent claim 22, Brown teaches wherein said HTML page (columns 8 & 10, lines 3-5 & 10-32) comprises a link to a document residing on a customer server (column 2, lines 36-42) and said link is coded to preserve dynamic information using the provider identifier as a cookie. Web cookies are well known in the art to provide data persistent session variables such as a user profile or preferences between a user's browser and a web server. As discussed above in claim 12, Brown does not teach wherein said link was coded to preserve information using the data persistence technique of URL munging. It would have been obvious to one of ordinary skill in the art at the time of the invention for Brown to have used URL munging to preserve session information, because URL/URI munging, the well known process of storing session identifiers and user variables as part of a web site's URL, would have reduced the notoriously well known privacy and security concerns regarding the cookie data in Brown. Said concerns, which could result in some web site users disabling cookies on their browsers and disabling the search capabilities in the process, would thus be averted.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US: 2003/0105807	06-2003	Thompson et al.
US: 2003/0163586	08-2003	Schnetzler
US: 6,208,975	03-2001	Bull et al.

US: 6,278,993	08-2001	Kumar et al.
US: 6,725,222	04-2004	Musgrove et al.
US: 6,282,567	08-2001	Finch et al.
US: 6,651,065	11-2003	Brown et al.

Google's, "Google's Custom WebSearch," 11/09/00, pp. 1-3,
http://web.archive.org/web/20001109054600/http://www.google.com/services/custom.html
Picosearch's, "Search Hosting Service," 03/01/00, pp. 1-4,
http://web.archive.org/web/20000303035644/www.picosearch.com/whatis.html &
http://web.archive.org/web/20000303062513/www.picosearch.com/whatpeoplesay.html

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (703) 305-7212. The examiner can normally be reached on M-F: 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

STEPHEN S. HONG
PRIMARY EXAMINER

FORM PTO-1449	ATTY. DOCKET NO.	SERIAL NO.
LIST OF PATENTS AND OTHER ITEMS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT	262/117	09/829,951
	APPLICANT: John Chad Parry	
(Use several sheets if necessary)	FILING DATE: April 11, 2001	GROUP: 2154

OIPE JUN 26 2001 PATENT & TRADEMARK OFFICE

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
ALB	AA	6,175,830	Jan. 2001	Maynard	707	5	May 1999
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						

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FOREIGN PATENT DOCUMENTS								
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION YES	NO
	AI							
	AJ							
	AK							

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)		
ALB	AL	Welcome to Atomz, Atomz Corporation [online], date of publication unknown [retrieved on 2001-05-16]. Retrieved from the Internet: <URL: http://www.atomz.com>.
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DC # 6191v2

EXAMINER: Adam L. Basehoar	DATE CONSIDERED: 05/19/04

EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant

FORM PTO-1449	ATTY. DOCKET NO.	SERIAL NO.
LIST OF PATENTS AND OTHER ITEMS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT	262/117	09/829,951
	APPLICANT: John Chad Parry	
(Use several sheets if necessary)	FILING DATE: April 11, 2001	GROUP: 2154

OIPE JC1600 JUN 26 2001 PATENT & TRADEMARK OFFICE

		OTHER DOCUMENTS CONT. (Including Author, Title, Date, Pertinent Pages, etc.)
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EXAMINER: Adam J. Basehoar	DATE CONSIDERED: 05/19/04

EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant

Notice of References Cited	Application/Control No. 09/829,951	Applicant(s)/Patent Under Reexamination PARRY, JOHN CHAD	
	Examiner Adam L Basehoar	Art Unit 2178	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-2003/0105807	06-2003	Thompson et al.	709/203
	B	US-2003/0163586	08-2003	Schnetzler, Steve	709/246
	C	US-6,208,975	03-2001	Bull et al.	705/14
	D	US-6,278,993	08-2001	Kumar et al.	707/3
	E	US-6,725,222	04-2004	Musgrove et al.	707/10
	F	US-6,282,567	08-2001	Finch et al.	709/219
	G	US-6,336,116	01-2002	Brown et al.	707/10
	H	US-6,651,065	11-2003	Brown et al.	707/10
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

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*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Google's, "Google's Custom WebSearch," 11/09/00, pp. 1-3, http://web.archive.org/web/20001109054600/http://www.google.com/services/custom.html
	V	Picosearch's, "Search Hosting Service," 03/01/00, pp. 1-4, http://web.archive.org/web/20000303035644/www.picosearch.com/whatis.html & http://web.archive.org/web/20000303062513/www.picosearch.com/whatpeoplesay.html
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.